UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,393	12/02/2004	Masahiko Maekawa	59243.00012	3066

32294   7590   06/03/2008

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EXAMINER
ROBINSON, KITO R

ART UNIT	PAPER NUMBER
3692	

MAIL DATE	DELIVERY MODE
06/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/516,393	MAEKAWA ET AL.
Office Action Summary	Examiner	Art Unit
	KITO R. ROBINSON	3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>19 March 2008</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1 and 3-5</u> is/are pending in the application.

   4a) Of the above claim(s) <u>2</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1 and 3-5</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>02 December 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>19 March 2008</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 12/02/2004.

2. Claims 1 & 3-5 have been amended.

3. Claims 1, 3, 4 & 5 are currently pending and have been examined.

4. The rejections to claims 1, 3, 4 & 5 have been updated to reflect the amendments.

Information Disclosure Statement

5. The Information Disclosure Statement filed on 19 March 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Response to Arguments

6. Applicant's arguments received on 25 March 2008 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. However, in an effort to elucidate the applicability of the selected prior art, the Examiner has provided a riposte to the Applicant's arguments.

8. With regard to the limitations of claim 1, Applicant argues "Nicastro does not relate to tracking the balances over multiple processes, and changes in the balances (i.e., balance amounts). In particular, Nicastro relates to tracking costs for parts of an asset, and not for tracking the balances associated with each of these parts when producing multiple assets. While the Office Action at the first paragraph of page 3 asserted that tracking costs for part is the same as tracking balances, this assumption is incorrect since, as described in the present application, costs are a component of the balance. Moreover, there appears to no way to adapt Nicastro to meet the technical challenge of the present application. Also, Nicastro does not disclose defining a correspondence between the stored balance and a new balance value. Thus, Nicastro does not disclose a structure for tracking and evaluating the balance changes. Moreover, there is no suggestion in Nicastro of the second terminal, distinct from the first to display the balances associated with each of the processes." See the claim rejection below.

9. With regard to the limitations of claim 1, Applicant argues "there is also no suggestion in Nicastro of third terminal, distinct from the first and second terminals, to allow a user to define the correspondences between the balances and the balance amounts or to define these at the third terminal. Thus, Applicants submit that Nicastro fails to disclose or suggest all of the features recited in claims 1 and 3-5. Reconsideration and allowance of claims 1 and 3-5 are therefore requested." See the claim rejection below.

Specification

10. The Examiner makes note of the Applicant's response to the Abstract objection and respectfully rescinds the objection.

Claim Rejections - 35 USC § 112

11. The Examiner makes note of the Applicant's response to claim 1 & 3-5 rejections and respectfully rescinds the 35 USC § 112 rejections.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections

set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

13. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that

are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are

summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or
      nonobviousness.

14. Claims 1, & 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. US

2002/0077919 A1, hereafter Lin in view of Nicastro et al. US 20020073114 A1, hereafter Nicastro.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art
of record within the body of this action for the convenience of the Applicant. Although the
specified citations are representative of the teachings in the art and are applied to the specific
limitations within the individual claim, other passages and figures may apply. Applicant, in
preparing the response, should consider fully the entire reference as potentially teaching all or
part of the claimed invention, as well as the context of the passage as taught by the prior art or
disclosed by the Examiner.

As per claim 1,

Nicastro '114 discloses:

- *information acquiring means for acquiring, for a process, first information on a process*

  item and a balance amount associated with the process item, wherein the first

  information is acquired from a first terminal corresponding to the process **(see at least**

  paragraph 0153: "The Cost Management Tools offer a comprehensive electronic

  process to monitor, manage and control cost from a central location, **track** and forecast

all estimates, **costs**, commitments, **revenue**, transactional events, and associated project information from the design to the construction and management of the resulting asset.

- *information updating means for updating the second information on the balance of the balance item, on the basis of the third information managed by the information management means and the first information acquired by the information acquiring means item* **(see at least paragraph 0352 & FIG. 10:** "Shown in FIG. 10 is a general representation of the how data is modified during use of the system by respective tools used in the system...The data from the property specifications database can be used by the cost estimate tool 1032, budgeting tool 1034, contracting tool 1036, payment tool 1038 and invoice tool 1040 to generate reports, contracts, payments and invoices, and such tools can be used to also modify data and return the modifications to the property specifications database.)

- *information providing means for providing a second terminal with the second information corresponding to one or more processes managed by the information management means* **(see at least paragraph 0043:** "In yet another embodiment, the invention comprises a method of allowing users to manage an asset comprising the steps of: providing an application server coupled to a network; providing, responsive to a user request, a data input tool to user client device...data modification tools including project management tools for modifying the data to the client device; and hosting a collaboration environment on said application server.)

- *first means for enabling a flexible setting of the third information according to a user's input* **(see at least paragraph 0313:** "The virtual area hierarchy can extend down many levels, depending upon a user's needs.")

Nicastro does not disclose the following however Lin does:

- *information management means for managing, for the process, second information on a balance of a balance item and third information on a correspondence between said balance of said balance item and the balance amount of said process* **(see at least paragraph 0005:** "The ERP system evolves from the manufacturing resource planning (MRPII) of manufacturers. The great advantage is that it integrates various business-running systems, including sale, manufacture, **finance, accounting**, human resource, and logistic support, so that all information in the enterprise can be sent to all members correctly in real time.

Further more Lin also discloses in at least paragraph 0026 "a first ERP server 401, a second ERP server 402, a third ERP server 403, etc)." A person of ordinary skill in the art would know a server can be coupled to a terminal.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Nicastro with the technique of Lin because the system can easily expand, maintain and increase its efficiency (as taught by Lin).

As per claim 3,

Nicastro discloses the limitations as shown in the rejection of Claim 1 above. Nicastro does not disclose the limitation of *the first means provides a program to a third terminal for enabling the setting of the third information according to the user's input at the third terminal.* However, Lin, in at least Paragraph 0061 discloses "the collaboration server hyperlinks to the host supplier server of the commodity to determine the distribution direction of the commodity ordering information. Following the direction of a collaboration **program**…that is, the information is uploaded to the CTO web ordering server (not shown) of each local ERP server (e.g., the first ERP server 401, the second ERP server 402, and the third ERP server 403, etc).

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Nicastro with the technique of Lin because the system can easily expand, maintain and increase its efficiency (as taught by Lin).

15. Claims 4 & 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin & Nicastro in view of Offenmuller US 2003/0172371.

As per claim 4,

Nicastro & Lin discloses the limitations as shown in the rejection of Claim 1 above. Nicastro & Lin does not disclose the limitation of *second means comprising a configuration means for configuring a display of the second information on the balance of the balance item according to the user's input and a display means for displaying the configured display of the second information.* However, Offenmuller, in at least claim 17 discloses "The method as claimed in claim 13, wherein a user of the system can configure the display apparatus personally."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Nicastro with the technique of Lin because the system can easily expand, maintain and increase its efficiency (as taught by Lin).

As per claim 5,

Nicastro & Lin discloses the limitations as shown in the rejection of Claim 1 above. Nicastro & Lin does not disclose the limitation of *the second means provides a program to the second terminal for configuring a display of the second information on the balance of the balance item according to the user's input at the second terminal.* However, Offenmuller, in at least paragraph 0006 discloses "It is an object of the invention to provide a system and a method for integrating and managing software applications, particularly MES applications, for industrial installations and/or industrial processes, so that the MES applications are available to a user in a simple and standard manner."

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Nicastro with the technique of Lin because the system can easily expand, maintain and increase its efficiency (as taught by Lin).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kito Robinson** whose telephone number is **571.270.3921.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Kambiz Abdi** can be reached at **571.272.6702**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

  http://portal.uspto.gov/external/portal/pair . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

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or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark**

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/Kito R Robinson/Examiner, Art Unit 3692

27 April 2008

/Harish T Dass/
Primary Examiner, Art Unit 3692